

REMARKS

In the restriction requirement, the Examiner pointed out several defects in the claims. These defects are addressed separately below.

Claims 34, 46 and 50 are said to contain incomplete sentences and claim 46 is further said to depend on a cancelled claim. These claims have been amended to correct the problems. No new matter has been introduced by the amendments.

Claims 57, 60-64 and 66 are said to be in non-statutory form. Claim 57 is cancelled and Claims 60-64 and 66 have been amended so that they are now directed at statutory subject matter. No new matter has been introduced by the amendments.

Claim 58, 59 and 76-79 are said to be unclear. Claims 58 and 76-79 are cancelled and Claim 59 has been amended to clarify the intent of the applicants. No new matter has been introduced by the amendments.

Claim 35 has also been amended for clarity. No new matter has been introduced by the amendment.

The restriction requirement is traversed on the basis that restriction requirements are optional in all cases (see MPEP § 803). If the search and examination of a set of claims can be made without serious burden, the Examiner must examine them on the merits, even though they may arguably be directed at distinct or independent inventions (see *id.*). In the present application, it is respectfully submitted that claims in Groups 1-3, Groups 7-9, Groups 10-12, Groups 13-15, Groups 18-20, Groups 1-15 and Groups 16-17 can be examined, respectively, without serious burden on the Office.

Firstly, claims in Groups 1, 2 and 3 are closely linked. The only difference among the groups are that Group 1 involves rat SKI-1 (SEQ ID NO:2), Group 2 involves mouse SKI-1 (SEQ ID NO:4) and Group 3 involves human SKI-1 (SEQ ID NO:6). As disclosed in the specification (page 19, lines 20-21) and Fig. 1, the rat, mouse and human SKI-1 sequences share a very high degree of homology. The rat and mouse sequences share a 98% identity and they both share a 96% identity to the human sequence. Thus, a proper search for one group would inevitably overlap with that for the others. As a consequence, the search result for one group would certainly have relevance to the others. Under this circumstance, it is not burdensome on the Office to examine the claims in these groups together. On the contrary, it will be unnecessarily burdensome on both the applicants and the Office to consider the highly related subject matter in several separate patent applications. Reclassifying Groups 1, 2 and 3 into one single group is respectfully requested.

For the same reasons, claims in Groups 7, 8 and 9, Groups 10, 11 and 12, Groups 13, 14 and 15, and Groups 18, 19 and 20 can be examined together, respectively, without serious burden on the Office. Reclassifying each of Groups 7, 8 and 9, Groups 10, 11 and 12, Groups 13, 14 and 15, and Groups 18, 19 and 20 into one single group is respectfully requested.

Secondly, claims in Groups 1-15 are closely linked. The claims in these groups all relate to the rat, mouse and human SKI-1 enzymes and various functional fragments thereof. Some claims are directed at the enzyme and the fragments themselves and others are directed at methods of producing and using the enzyme and the fragments. Most literatures that cover one aspect of SKI-1 as mentioned above is likely to cover or refer to other literatures that cover the other aspects as well. Thus, a proper search for one group would inevitably overlap with that for the others. Accordingly, it is not burdensome on the Office to examine these claims together. On the contrary, it will be unnecessarily burdensome on both the applicants and the Office to consider the highly related subject matter in several separate patent applications. Reclassifying Groups 1-15 into one single group is respectfully requested.

Thirdly, claims in Groups 16-17 are closely linked. Both groups of claims relate to a peptide of at least seven amino acids as recited in the claims and methods of using the peptide. A proper search for one group would inevitably overlap with that for the other. For example, a proper search for both groups of claims would involve a search for the peptide. If the peptide is found patentable, the claims of both groups will be considered patentable. Accordingly, examination of claims in both groups can be conducted without serious burden. On the contrary, it will be unnecessarily burdensome on both the applicants and the Office to consider this highly related subject matter in several separate patent applications. Reclassifying Groups 16-17 into one single group is respectfully requested. Furthermore, for the same reason discussed above, amended Claim 59 belongs to this combined group.

In view of the above traverse, it is respectfully requested that the restriction requirement with regard to Groups 1-3, Groups 7-9, Groups 10-12, Groups 13-15, Groups 18-20, Groups 1-15 and Groups 16-17 be reconsidered and withdrawn.

Wherefore examination on the merits is respectfully requested.

No extension of time is believed to be necessary and no fee is believed to be due in connection with this response. However, if any extension of time is required in this or any subsequent response, please consider this to be a petition for the appropriate extension and a request to charge the petition fee to the Deposit Account No. 17-0055. No other fee is

believed to be due in connection with this response. However, if any fee is due in this or any subsequent response, please charge the fee to the same Deposit Account No. 17-0055.

Respectfully submitted,



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